

REMARKS

Favorable reconsideration is respectfully requested in view of the foregoing amendments and the following remarks.

I. CLAIM STATUS AND AMENDMENTS

Claims 1-7 were pending in this application when last examined.

Claims 1-7 were examined on the merits and stand rejected.

Claims 2-4 are amended to clarify the claimed invention.

Claim 1 is cancelled without prejudice or disclaimer thereto.

Claims 8 and 9 are newly added. Support for such claims can be found on page 14, line 24 to page 15, line 16, of the specification as filed.

No new matter has been added.

II. OBVIOUSNESS REJECTION

On pages 3-6 of the Office Action, claims 1-7 were rejected under 35 U.S.C. § 103(a) as obvious over Koizumi et al. (US 2002/0064836) in view of Plumbridge & Vimr (Journal of Bacteriology, 1999), and further in view of Tabata et al. (Enzyme & Microbial Technology, March 2002), and further in view of IUBMB enzyme nomenclature (EC 5.9.3.1).

Applicants respectfully traverse this rejection as applied to the amended claims.

Applicants note that the processes of claims 2 and 5 as well as the claims that depend upon such claims inherently possess an approximately 44% yield. In other words, 100 mM of GlcNAc produces 43.7 mM NeuAc. Applicants note that it is unnecessary to recite such in the claims as this is an inherent property of the recited invention.

Further, Applicants note that such yield can only be attained if all of the components recited in amended claim 2 or claim 5 as pending are combined.

In particular, attached herewith is a Declaration by one of the inventors (Attachment A) and an article authored by the present inventors (Attachment B; Hamamoto et al.) published after the filing date of this application. In the Declaration, the Declarant indicates a person of skilled in the art would not have a reasonable expectation of success to arrive at the claimed invention.

For instance, as noted in the discussion on pages 1948 and 1949 of the attached Hamamoto et al., the inventors engaged in numerous different experiments with different combinations of components before arriving at the claimed invention which is an efficient method for production of CMP-NeuAc. Thus, Applicants respectfully suggest that a person of skilled in the art would not be motivated to combine the elements present in the three separate cited references to arrive at the claimed invention. In other words, person of skilled in the art would not have a high likelihood of success to arrive at the claimed invention and therefore would not be motivated to combine such.

Also, in regard to new claims 8 and 9, Applicants note that such is not taught or suggested by the cited art.

Thus, for the above noted reasons, Applicants respectfully suggest that this rejection is untenable, as applied to the amended claims, and should be withdrawn.

CONCLUSION

In view of the foregoing amendments and remarks, it is respectfully submitted that the present application is in condition for allowance and early notice to that effect is hereby requested.

If the Examiner has any comments or proposals for expediting prosecution, please contact the undersigned attorney at the telephone number below.

Respectfully submitted,

Toshitada NOGUCHI et al.

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